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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/715,682

11/18/2003

Kris S. Stanhope

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06/08/2006

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EXAMINER

DRODGE, JOSEPH W

ART UNIT

PAPER NUMBER

1723

DATE MAILED: 06/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/715,682	Applicant(s) STANHOPE ET AL.	
	Examiner Joseph W. Drodge	Art Unit 1723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The instant Specification does not provide clear support for the valve being "unitary" as now recited and contains no such terminology. Recitation in claim 1 of the valve being 'unitary' thus constitutes NEW MATTER.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Silverwater patent 3,262,565.

With respect to claims 1,15 and 18, Silverwater discloses a filter assembly having a housing 1,30 open at an upper end, an annular filter media/core assembly 40,50,41 disposed in said housing, an end plate 8 in combination with ring part 13, secured to the housing and closing the open end thereof, the end plate 8,13 having first inlet opening means 7,10, second inlet opening means 7,16 and outlet opening means 6, a combination valve 11 disposed between the annular filter media/core assembly and the end plate for controlling fluid flow through the first inlet opening means and the second

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inlet opening means, the combination valve including a first annularly outer portion cooperating with the first inlet opening means and a second annular interior portion cooperating with the second inlet opening means, the second portion having more resistance to fluid flow than the first portion (column 9, lines 53-55), whereby, in normal operation, the first portion will yield prior to the second portion and fluid flow will pass through the first inlet opening means, the annular filter media/core assembly and then be discharged through said outlet opening means and when the annular filter media/core assembly begins to clog, pressure upstream of the first portion will build and upon attainment of a predetermined pressure, the second portion will open the second inlet opening means and fluid flow can pass through the second inlet opening means and out the outlet opening means bypassing the annular filter media/core assembly (see column 5, lines 27-50 and column 9, lines 32-42).

Regarding claims 2 and 17, the valve comprises a spring disposed between the top of the annular filter media/core assembly and the inside of the housing for biasing the annular filter media/core assembly toward the end plate to retain the combination valve in place (column 5, lines 39-40), also see column 6, lines 39-46.

Regarding claims 3, 16 and 18, the combination valve comprises an annular member, with the first portion extending outwardly from a central portion and the second portion extending inwardly from the central portion, the second portion being stiffer than the first portion; the annular filter element engaging the central portion of the combination valve between the first portion and the second portion to retain the

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combination valve in place (see the options for valve structure disclosed in column 9, lines 33-55).

For claim 4, the annular filter media/core assembly includes a upper central core 35 surrounded by filter media and the lower end of the central core engages the central portion of the combination valve.

For claim 5, the end plate portion 13 has an inclined surface inclined with respect to the longitudinal axis of the housing and a transverse surface transverse to the longitudinal axis of the housing (figure 1), the first inlet opening means being disposed in the inclined surface and the second inlet opening means being disposed in the transverse surface (shown in figure 1).

For claims 6 and 7, the 1st and 2nd inlet opening means comprises a plurality of openings (column 5, lines 27-28).

For claim 8, the first and second inlet opening means each comprised a plurality of openings arranged generally in a circle around the axis of the filter assembly, the circle of openings for the first inlet opening means being substantially concentric to the circle of openings for the second inlet opening means, with the annular filter/media core assembly urging the combination valve against the end plate in the region between the two circle of openings (figures 2 and 3 and column 5, lines 27-28).

For claim 9, the annular filter media/core assembly comprises a core 35/41, a filter media 40 or 50 surrounding the core and end caps 42,43,52,53 at the ends of the filter media, the filter media and end caps being fabricated from materials that can be

bonded to fuse the components to one another and preclude any significant fluid flow therebetween (column 6, lines 28-32).

For claim 10, the filter media and the end caps are ultrasonically or otherwise welded to one another (column 6, lines 29-30).

For claim 11, the second portion has a surface or portion engaging the end plate 13 and a surface engaging section 52 of the central core and another surface or portion that engages an end plate.

For claim 12, there is a manifold cover or lid 27 secured to the end plate, the lid having outwardly extending recesses to receive inlet and outlet lines 2 and 3, also see gaskets 29.

For claim 13, see complementary retaining means between the gasket and the sides of the recess for retaining the gasket in the recess (column 5, lines 51-59).

For claim 14, the complementary retaining means include projections on either the gasket or a wall of the recess, wherein when the gasket is inserted into the recess, it will be retained therein (figure 1 and column 5, lines 51-59).

Applicant's arguments filed on May 1, 2006 have been fully considered but they are not persuasive. It is argued, particularly with respect to dependent claims 3,6 and 18, that the valve of Silverwater is not unitary in that it does not simultaneously perform functions of a check valve and bypass valve. The following is submitted: the instant claims contain no recitation of functional or structural language for preventing reverse flow of a fluid or other check valve functions; the Silverwater valve does perform a bypass or relief valve function, which is claimed((column 8, lines 26-31 and 58-69); the

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Silverwater valve does perform a combination or dual role of a bypass valve and pressure-relief valve (column 8, lines 58-69).

Regarding claims 2 and 17, it is argued that Silverwater lacks a filter-biasing spring. However, it is submitted that column 6, lines 39-46 describe such function of coil spring 63.

For claim 5, it is argued that the end plate portion 13 of Silverwater contains no "inclined surface", however the surfaces of plate 13 defining orifices 10 are inclined.

For claim 11, it is argued that the disc 11 of Silverwater lacks a 2nd portion that engages the end plate and surface engaging the central core; however, figure 1 shows disc 11 extending between end plate 8 and plate 13 that has an axially extending core portion.

For claim 12, it is argued that manifold 27 of Silverwater bears no relation to a lid having an outwardly extending recess receiving a gasket. However, such manifold does function as a lid for the upper portion of the Silverwater filter and has a recess on its outer portion for sealing members 28 and 29.

For claims 13 and 14, it is argued that there is no complementary retaining means; see column 5, lines 51-59 of Silverwater.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Drodge at telephone number 571-272-1140. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker, can be reached at 571-272-1151. The fax phone number for the examining group where this application is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or Public PAIR, and through Private PAIR only for unpublished applications. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JWD

June 6, 2006


JOSEPH DRODGE
PRIMARY EXAMINER